

Application No. 09/666866
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Amendment
Attorney Docket No. S63.2N-5605-US04

REMARKS

This Amendment is in response to the Final Office Action dated **September 26, 2003** and is filed along with an RCE in order to allow the Applicant to put the claims in better condition for appeal.

In the Office Action, claims 43, 57 and 62 were objected to; claims 38, 45, 60, 63, 77, 78, 80 and 81 were objected under 35 U.S.C. §112, first paragraph; claim 87 was rejected under 35 U.S.C. §112, second paragraph; claims 77, 78, 83 and 84 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. 5,102,417 to Palmaz; claims 85, 86, 87, 88 under 35 U.S.C. §103(a) as being obvious over Palmaz in view of U.S. 6,156,052 to Richter et al (Richter); claims 36, 39-43, 46-56, 58-61, 63-74, 76-79 and 81-88 were rejected under §103(a) as being obvious over EP 0540290 to Lau et al (Lau) in view of Palmaz; and claims 37, 38, 44, 45 and 80 were rejected under §103(a) as being obvious over Lau and Palmaz, as applied above and further in view of U.S. 5,725,572 to Lam et al (Lam). In addition to the above, in the Final Office Action claim 57 was objected to as being dependent upon a rejected base claim but allowable of rewritten in independent form.

Claims 46-56, 58-66, 68-78, 81-82 and 85-88 have been canceled without prejudice or disclaimer. Applicants reserve the right to prosecute these claims at a later date.

In addition to the above, Applicants have added new claims 89-96. Applicants note that claims 90-96 are similar to claims 46 and 64-69 which were presented and subsequently canceled in copending, related U.S. App. No. 08/511,076 from which the present Application claims priority..

The following paragraphs are provided with headings that correspond to those presented in the Office Action.

Claim Objections

In the Final Office Action claims 43, 57 and 62 were objected to.

Claims 43 and 62 have been canceled without prejudice or disclaimer thereby mooted the objections.

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Claim Rejections – 35 USC §112

Regarding claims 38 and 45, in the Final Office Action the claims were rejected under §112, first paragraph because in the Examiner's view "there is no clear original support for a differing "pattern" of bands, especially one band having two adjacent bands with different struts lengths from the one band claimed." While Applicants consider the claims to be fully supported, Applicants have nonetheless amended the claims to refer only to the respective differences in "length" of the struts of adjacent bands. The claims are fully supported by FIG. 4 as well as the specification as originally filed.

Regarding the §112, first paragraph rejection to claims 60-63, 77, 78, 80 and 81, it is asserted in the Final Office Action that the term "non-parallel" does not have original support and that it is considered to constitute new matter.

As to claims 60-63, 77 and 80, the rejection is moot, the claims having been canceled without prejudice or disclaimer.

As to the remaining claims, Applicants disagree with the assertion of the Office Action. The specification states (at page 4, line 16):

Interconnecting elements 20 extend from one end portion 19 of one segment 16 to another end portion 19 of another adjacent segment 16 but not to an oppositely positioned end portion 19 of an adjacent segment 16.

This statement provides support for the language in question. Withdrawal of the rejection is respectfully requested.

In the Final Office Action claims 63, 77 and 81 were rejected under §112, first paragraph in that it was asserted that the range "at least six struts" recited in each claim lacked original support. Although Applicants maintain that the language of 'at least six struts' is fully supported by the specification, these claims have been canceled without prejudice or disclaimer thereby mooting the rejection.

In the Final Office Action claim 87 was rejected under §112, second paragraph. Applicants have amended claim 87 to correct a clerical error. The term 'proximal most cylindrical shaped segment' has been corrected to read 'distal most cylindrical shaped segment'. As a result the rejection is overcome.

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Claim Rejections – 35 USC §102

In the Final Office Action claims 77, 78, 83 and 84 were rejected under §102(b) as being anticipated by Palmaz. The Final Office Action refers to Fig. 10 of Palmaz but fails to indicate how one can interpret Palmaz as having at least six struts between each circumferentially adjacent interconnecting element on a given cylindrical shaped segment as the instant claims describe.

Applicants note that claims 77 and 78 have been canceled without prejudice or disclaimer thereby mooted the rejection as to these claims.

Applicants have amended claim 84 to remove the at least six strut limitation and to recite that the stent has a sidewall with a plurality of openings therethrough and that each of the openings in the sidewall of the stent is bounded by a portion of one cylindrical shaped segment, a portion of another cylindrical shaped segment and two interconnecting elements.

The combination of features is not disclosed in Palmaz in that the Palmaz stent includes openings which are not bounded by portions of two different cylindrical shaped segments and by two interconnecting elements. Therefore, Palmaz does not anticipate claim 84. Claim 83, dependent from claim 84 is similarly not anticipated by Palmaz.

Claim Rejections – 35 USC §103

Palmaz in view of Richter

In the Final Office Action claims 85-88 were rejected under §103(a) as being obvious over Palmaz in view of Richter. Richter is relied upon to show more than one middle segment.

Claims 85-88 have been canceled without prejudice or disclaimer.

Lau in view of Palmaz

In the Final Office Action claims 36, 39-43, 46-56, 58-61, 63-74 and 81-88 were rejected under §103(a) as being obvious over Lau in view of Palmaz.

Applicant disagrees that the case for obviousness has been made and is considering the possibility of appealing the rejection.

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Lau and Palmaz further in view of Lam

In the Final Office Action claims 37, 38, 44, 45 and 80 were rejected under §103(a) as being obvious over Lau and Palmaz, as applied above and further in view of Lam. Claims 37 and 38 depend from independent claim 36. Claims 44 and 45 depend from independent claim 43. Claim 80 depends from independent claim 77.

Applicant disagrees that the case for obviousness has been made and is considering the possibility of appealing the rejection.

Allowable Subject Matter

In the Final Office Action claim 57 was objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form. Claim 57 has been rewritten in independent form with several minor syntactical corrections.

CONCLUSION

In view of the foregoing it is believed that the present application is in condition for allowance. Early action to that effect is earnestly solicited.

Respectfully submitted,

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